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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THORSTEN O. LAUX and BERND EILERS

Appeal 2008-0576
Application 10/025,497
Technology Center 2100

Decided: September 26, 2008

Before HOWARD B. BLANKENSHIP, JAY P. LUCAS, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-45, which are all the claims in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part, but designate the affirmed rejection as a new ground of rejection as permitted by 37 C.F.R. § 41.50(b).

Appellants' invention relates to a tree data structure. Claims 1 and 38 are illustrative.

1. A data processing system in a client and server system, the server providing the client with an instruction data set in a specified instruction format in response to a content data request from the client, the system comprising:

a server computer comprising:

a memory including a server program that provides one or more content data request properties of the content data request made by the client, that prepares the instruction data set having the specified instruction format and including a plurality of instruction element data sets each representing a specified instruction element of the instruction format and generated by at least one instruction element generating application in an instruction format set up sequence, that includes an instruction format configuration file containing a tree data structure including a plurality of instruction format nodes, each of the instruction format nodes indicating a particular combination of instruction elements having the specified instruction format and having associated with it a node selection criterion, that searches said tree data structure with said determined content data request properties and selects an instruction format node whose associated node selection condition matches said determined content data request properties, and that prepares the instruction data set to be sent to the client by executing the instruction element generating application of the selected instruction format node; and

a processor that runs said server program.

38. A computer-readable memory device encoded with a tree data structure having entries which are accessed by a program that provides at least one client by a serve in a client and server system, with an instruction data set in a specified instruction format in response to a content data request, wherein the program is encoded in the memory device and is run by a processor, the entries comprising:

a plurality of instruction format nodes, each instruction format node indicating a specified combination of instruction elements including a particular instruction format and having associated with it a node selection criterion.

The Examiner relies on the following references as evidence of unpatentability.

Gu	US 6,892,230 B1	May 10, 2005
Brandow	US 6,938,041 B1	Aug. 30, 2005

Claims 1-45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brandow and Gu.

The Rejection

Because Appellants' arguments rely on the information content of the claimed "data structure," we sustain the rejection of claims 1-42, 44, and 45.

Instant claim 1, for example, recites a server computer memory that includes a tree data structure. Instant claim 18, as another example, recites a method that includes searching a tree data structure. Instant claim 38, as a further example, recites a computer-readable memory device encoded with a tree data structure.

However, the particular information content that the tree nodes are deemed to represent does not necessarily change the underlying machine, process, or product set forth in the respective claim. Data that does not modify the underlying substrate or process is known as nonfunctional descriptive material. The content of nonfunctional descriptive material carries no weight in the analysis of patentability over the prior art. *Cf. In re*

Lowry, 32 F.3d 1579, 1583 (Fed. Cir. 1994) (“*Lowry* does not claim merely the information content of a memory. . . . [N]or does he seek to patent the content of information resident in a database.”). *See also Ex parte Nehls*, <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071823.pdf>; *Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (nonprecedential) (Fed. Cir. Appeal No. 2006-1003, *aff’d* Rule 36 Jun. 12, 2006); *Manual of Patent Examining Procedure* § 2106.01 (8th ed., Rev. 7, Jul. 2008).

What the tree nodes might be deemed to represent in memory or when manipulated in process steps does not change the essential characteristics of the memory or the steps.

Instant claim 1, for example, recites a “tree data structure including a plurality of instruction format nodes.” The recitation, thus far, requires at most a tree data structure having a plurality of nodes. Claim 1 goes on to recite “each of the instruction format nodes indicating a particular combination of instruction elements having the specified instruction format.” What the nodes might “indicate,” thus far, carries no weight in the patentability analysis. Claim 1 further recites each of the nodes “having associated with it a node selection criterion.” A “selection criterion” suggests some kind of function, but we need not determine whether it would represent functional descriptive material if it were to form part of the node. The criterion is no more than “associated” with the node. Each node in any tree data search has selection criteria associated with that node; those criteria determine whether the node is selected or not selected in a search.

Appellants acknowledge that Brandow teaches at least two tree data structures, including one that is searched to find data (*see, e.g.*, Reply Br. 7.) Gu also indicates that tree data searches were well known in the art (*e.g.*, col. 16, ll. 60-67).

Appellants' arguments based on differences between the content of the instant tree data structure vis-à-vis the prior art data structures do not persuade us that the claims are rejected in error.

We sustain the § 103(a) rejection of claims 1-42, 44, and 45. We designate the affirmance a new ground of rejection (37 C.F.R. § 41.50(b)).

We agree with Appellants, however, that the applied references do not demonstrate the obviousness of the subject matter of claim 43. Contrary to the rejection, we do not find that Brandow teaches, at least, inserting content data in the places indicated in an instruction format template by at least one instruction element generating application. Such a step is not taught by the "Normalizer" 263 described at column 7, lines 42 through 49 of the reference. Accordingly, we do not sustain the rejection of claim 43.

CONCLUSION

We affirm the rejection of claims 1-42, 44, and 45 under 35 U.S.C. § 103(a) as being unpatentable over Brandow and Gu, in what we designate a new ground of rejection. We reverse the § 103(a) rejection of claim 43.

With respect to the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides that "Appellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this

case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART -- 37 C.F.R. § 41.50(b)

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